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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,489	08/27/2001	James Malcolm Vignoles	01.018.01	2875
7590 Zilka-Kotab, PC P.O. Box 721120 San Jose, CA 95172-1120	01/09/2007		EXAMINER PYZOWCHA, MICHAEL J	
			ART UNIT 2137	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/09/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/938,489	VIGNOLES ET AL.	
	Examiner	Art Unit	
	Michael Pyzocha	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 November, 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,9-14,21-26 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-2,9-14,21-26,33-37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

1. Claims 1-2, 9-14, 21-26, and 33-37 are pending.
2. Amendment filed 11/13/2006 has been received and considered.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Each independent claim has been amended to include at least the phrase "tangible computer readable medium", nowhere in the specification is this phrase disclosed therefore the specification fails to provide antecedent basis for this amendment.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-2, 9-14, 21-26, and 33-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

Art Unit: 2137

written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Each independent claim has been amended to include at least the phrase "tangible computer readable medium", nowhere in the specification is this phrase disclosed therefore this amendment fails to comply with the written description requirement.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-2, 9-14, 21-26, and 33-37 are rejected under 35 U.S.C. 101. Regarding claims 1-2 and 9-12, Applicant discloses "a computer program product". The first issue is whether the claimed program product is limited to physical articles or objects to establish a statutory category of invention as a manufacture, since it's not a machine, process, or composition of matter. Absent an explicit and deliberate definition in the

Art Unit: 2137

disclosure (which Examiner is unable to find), a program product is just the software piece and fails to include the physical article or object as the medium which establishes the statutory category. The second issue is whether the logic produces a useful, concrete, and tangible result. In this instance, the final result achieved is conditional. Therefore, Examiner has reviewed the final result achieved for each condition covered, both those actually recited and those covered but not recited. If any fail to be a useful, concrete, and tangible result, then the claims are properly rejected under 35 U.S.C. 101. In the instant case, Examiner believes claim 1 does not produce a useful, concrete, and tangible result in the instance when the update status of the current malware scanner matches the update status of the previous malware scanner. Based on the two issues presented above, claims 1-2 and 9-12 are rejected under 35 U.S.C. 101.

Claims 13-14 and 21-24 do not appear to have the first issue presented above, but like claim 1, a useful, concrete, and tangible result does not appear to exist in every instance of the conditional statements covered. Like claim 1, claim 13 does not appear to produce a useful, concrete, and tangible result in the instance when the update status of the current malware scanner matches the update status of the previous malware

scanner. Based on this issue, claims 13-14 and 21-24 are rejected under 35 U.S.C. 101.

Claims 25-26 and 33-37 purport to be apparatus claims, but appear to be lacking an essential element under 112, 2nd, to support the preamble and make them apparatus claims. As such, they appear to be merely software (functional descriptive material), *per se*, and non-statutory under 35 U.S.C. 101 rather than an actual apparatus. Claim 25 also appears to have the same issue of claim 1 and claim 13 regarding the conditional nature of the final result achieved. Based on these two issues, claims 25-26 and 33-37 are rejected under 35 U.S.C. 101.

Response to Arguments

8. Applicant's arguments filed 11/13/2006 have been fully considered but they are not persuasive. Applicant argues that each claim has a useful, concrete, and tangible result. With respect to this argument, in each of the if clauses put forth in the claims there is a useful, concrete, and tangible result, however as put forth above, there is no useful, concrete, and tangible result when the update status of the previous scanner is the same as the update status of the current scanner. When these statuses are the same the only steps being performed are reading and comparing and clearly these do not result in a

Art Unit: 2137

useful, concrete, and tangible result. Furthermore, Applicant's specification (page 8 lines 14-17) state that when the versions are the same the file is not modified and this appears to be the only mention of the situation when both versions (statuses) are the same.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner

Art Unit: 2137

can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJP


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER